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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,629	12/27/2001	Patrick Caceres	102549.01	8010

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/27/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/026,629

Applicant(s)

CACERES ET AL

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 13 is objected to because of the following informalities: "Vapour" is misspelled.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what "under the form of particles" means.

4. Claims 6-7, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what how the particles are "in excess...compared to when they are in the full swollen state" and "excess is from 5 to 10 %...to just fill the bag completely" means.

5. Claims 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The terms "longer" and "shorter" are relative terms which renders the claim indefinite. The terms "longer" and "shorter" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Art Unit: 1774

6. Claims 8, 12, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "The composition" lacks antecedent basis. Also regarding claim 8, it is not clear what "semi-synthetic nature" defines.

7. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "The body" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-3, 11, 14-15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,669,894 to Goldman et al.

2. Goldman teaches an absorbent member comprising a permeable (nonwatertight) nonwoven thermoplastic fibers and fibrous materials which form an envelope having walls. The fibrous materials include naturally occurring fibers of cotton, or synthetic fibers of polyesters. See col. 21, lines 20-55 and col. 42, lines 1-8. The fibers may be of single or combined polyethylene, polyester, PET, polypropylene, hydrophilic or hydrophobic see col. 26, lines 10-35, and col. 37, lines 20-49. The fibers have various lengths and may be short or long synthetic fibers with hydrophilic surfaces of cross-linked cellulose, polypropylene, polyester, and many others. See col. 36, lines 34-55 and col. 37, lines 55-65. A hydrogel-forming absorbent polymer

Art Unit: 1774

such as sodium polyacrylate is within the envelope. See col. 31, lines 40-65, col. 32, lines 1-15, lines 55-65, col. 40, lines 35-55, Example 3, col. 17, lines 1-28, Table 1, col. 22, lines 30-41.

Per Applicant's disclosure that the polymer absorbent is sodium polyacrylate, Goldman's same material, inherently is a "core/shell" polymer and inherently functions the same, e.g. "under the form of particles...comprising a core of less cross-linked...". Goldman includes the same materials in his absorbent member, hence, the envelope being collapsible is inherently provided.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-10, 12, 13, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,669,894 to Goldman et al. in view of USPN 6,075,177 to Bahia et al.

Goldman does not teach a viscose fiber (claims 4-5, 10, 12, 16, 18). Bahia teaches a wound dressing. At col.3, lines 40-43, Bahia teaches a viscose rayon or viscose cotton fiber. Bahia further teaches several different viscose fibers are derived from cellulose depending upon the absorbency and tenacity required. Hence it would have been obvious to one of ordinary skill in the art to modify the absorbent members of Goldman to further include viscose fibers since

Art Unit: 1774

Bahia teaches doing so provides an absorbent nonwoven material with varying degrees of absorbency and tenacity at col. 3, lines 40-60.

11. Goldman does not explicitly teach the longer fibers of viscose. However, as Goldman explained above, fibers can be of any length. Since Bahia teaches viscose fibers as a suitable fiber in a nonwoven absorbent material, it would have been obvious to one of ordinary skill in the art to modify the absorbent of Goldman to provide a viscose fiber of longer fibers since Bahia teaches providing a viscose fiber to vary absorbency.

12. Goldman does not explicitly teach viscose fibers from 70 to 90% (claims 8, 12, and 18).

Goldman, however, teaches at col. 36, lines 24-25 that fibers may be present from 10 to 90% in order to produce desired properties for absorbency. Hence it would have been obvious to one of ordinary skill in the art to modify the absorbent member of Goldman to vary the percentages of fibers, be it viscose or polyester, or polypropylene since Goldman teaches varying the weight percentage by blending fibers with cellulose for example, results in a high compressive modulus, improving performance at col. 36, lines 45-65. Additionally, Bahia teaches viscose fibers may be used in a cellulose and nonwoven as cited above.

Regarding claims 6, 7, 19, and 20, the Examiner takes the position that since the polymer absorbent particles are the same (sodium acrylate), then how they react in excess or theoretical weight is inherent. Further these claims are based on process limitations which are not given any weight in product claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F.

Art Unit: 1774

2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

13. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,669,894 to Goldman et al. in view of USPN 6,075,177 to Bahia et al., <sup>or</sup> ~~and~~ USPN 5,147,646 to Graham.

14. Regarding method for relieving pain of claim 13, Goldman does not teach this method.

However, Bahia teaches a wound dressing and at col. 2, lines 30-50 applying it to heal wounds (relieve pain). Since the same materials are used in Bahia as in Goldman, the function (“particles with water...through envelope...water vapour desorbed...”) would be the same. Hence, it would have been obvious to one of ordinary skill in the art to modify Goldman’s absorbent material to relieve pain since Bahia/ teaches absorbent materials may be used to heal wounds. Also Graham teaches a hydrogel containing envelopes in a pouch, where hydrogel is swollen when it is immersed and contacts water. The hydrogel absorbs the water, causing the hydrogel to swell to fill the envelope. The hydrogel absorbs water through the water-permeable or porous walls (nonwatertight) of the envelope. The pouch is generally used in wound dressings, contacting the wound (sore part on a body). See col. 1, lines 33-50 and col. 2, lines 45-60. Hence, it would have been obvious to one of ordinary skill in the art to use Goldman’s absorbent article to relieve pain, and apply the article on a sore part of a body, allowing water vapor to be desorbed from hydrogel particles. Graham teaches in claim 2 a method of treating a patient which involves applying an article to a patient’s body. The fibers in the article of Gram go through the same process as instantly claimed. See col. 7, lines 40-60 and col. 8, lines 25-35.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
12. USPN 5,129,391 to Brodsky et al. teaches a thermal pack of a cellulose with a gel such as cryogenic gel to provide cold relief to an injury.
13. USPN 5,977,428 to Bozigian et al., teaches an absorbent hydrogel particles which are cross-linked water swollen polymers inside a bag or sachet made of any porous material such as a non-woven cotton, polyester, or polypropylene.
14. USPN 5,129,391 to Brodsky et al. teaches thermal packs containing gel and a nonwoven substrate.
15. USPN 6,169,223 to Mahr et al. teaches a compress for medical treatment comprising nonwoven textile fabric and gel.
16. USPN 5,486,206 to Avery teaches a reusable thermal pack and flow retardant gel used inside an envelope of polymeric material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.



Art Unit: 1774

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus  
Examiner  
Art Unit 1774

March 24, 2003

SYLVIA M. KELLY  
PATENT EXAMINER  
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